

**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF NEW YORK**

FORD OXAAL,

Plaintiff and Counter-Defendant,
v.

INTERNET PICTURES CORPORATION,

Defendant and Counter-Claimant.

No. 00-CV-1863
(LEK/DRH)

APPEARANCES:

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**DAVID R. HOMER
U.S. MAGISTRATE JUDGE**

OF COUNSEL:

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MEMORANDUM-DECISION AND ORDER

Presently pending is the motion of defendant Internet Pictures Corporation (“iPIX”) for an order pursuant to Fed. R. Civ. P. 15(a) and 16(b) granting leave to file and serve an amended answer and counterclaim. Docket No. 13. Plaintiff Ford Oxaal (“Oxaal”) opposes the motion. Docket No. 15. For the reasons which follow, the motion is granted.

I. Background

Oxaal commenced this action on December 5, 2000 by filing a complaint alleging patent infringement. Compl. (Docket No. 1). iPIX filed and served an answer and counterclaim on February 1, 2001. Docket No. 5. On March 27, 2001, a Uniform Pretrial Scheduling Order (UPSO) was entered which established a deadline of August 31, 2001 for amendment of pleadings and May 1, 2002 for completion of discovery. Docket No. 10. iPIX filed the instant motion on February 1, 2002 seeking leave to file and serve an amended answer and counterclaim asserting an addition defense based on a recent decision by the United States Court of Appeals for the Federal Circuit. Docket No. 13 & Ex. 9 at ¶ 24.

II. Discussion

Because iPIX seeks leave to amend its answer after the deadline in the UPSO for doing so has passed, it must first demonstrate “good cause” to extend that deadline. See Parker v. Columbia Pictures Indus., 204 F.3d 326, 340 (2d Cir. 2000); see also N.D.N.Y.L.R. 16.1(f) (“Deadlines . . . shall be strictly enforced and shall not be modified by the court except upon a showing of good cause”); UPSO, ¶ 1 (same). For purposes of Rule

16(b), “‘good cause’ requires ‘the party seeking relief to show that the deadlines cannot reasonably be met despite the diligence of the party needing the extension.’” Robinson v. Town of Colonie, No. 91-CV-1355, 1993 WL 191166, at *3 (N.D.N.Y. June 3, 1993) (McCurn, J.); see also Julian v. Equifax Check Services, Inc., 178 F.R.D. at 16; Pulsecard, Inc. v. Discover Card Services, Inc., 168 F.R.D. 295, 301 (D. Kan. 1996). The inquiry focuses on the moving party’s reason for requesting the extension. Julian v. Equifax Check Services, Inc., 178 F.R.D. 10, 16 (D. Conn. 1998). Events occurring after the entry of a scheduling order which were reasonably unforeseeable may suffice to establish good cause. See, e.g., Deghand v. Wal-Mart Stores, Inc., 904 F. Supp. 1218, 1220-21 (D. Kan. 1995) (discovery of ground for additional cause of action ten weeks after deadline had passed for amendment of pleadings established good cause for extension); Robinson v. Town of Colonie, 1993 WL 191166, at *3 (good cause to extend deadline to amend pleadings found one year after deadline had passed where party learned of basis for amendment during discovery).

Here, iPIX contends that good cause is established by the holding in Symbol Technologies, Inc. v. Lemelson Med., 277 F.3d 1361 (Fed. Cir. 2002), holding that an equitable defense of prosecution laches could be asserted against a claim of patent infringement commenced after an unreasonable and unexplained delay even though the plaintiff complied with all pertinent statutes and rules. That decision was filed on January 24, 2002. iPIX filed the instant motion eight days later and five months after the deadline for amendment of pleadings established in the UPSO. iPIX contends that the legal basis for the defense of prosecution laches did not exist until the decision in Symbol Technologies, thus providing good cause under Rule 16(b). Oxaal contends that the decision in Symbol Technologies merely restated a legal principle which has existed for

eighty years and, therefore, affords iPIX no good cause for failing to assert the defense previously.

It appears clear from a review of the Symbol Technologies decision that it marked a significant change in the law. First, it reversed the district court's determination that a claim of prosecution laches was unavailable as a matter of law. Second, it rejected as precedent two prior "non-precedential" opinions of the Federal Circuit holding that a claim of prosecution laches was unavailable as a matter of law. Symbol Technologies, 277 F.3d at 1366-68. Third, the dissenting opinion describes the holding as establishing a new rule of law and departing from the court's "long-standing rule." Id. at 1369. Finally, the fact that six amici curiae briefs were received by the court further confirms the significance of the case. Thus, it appears that the Symbol Technologies decision provided a legal basis for iPIX to assert the defense of prosecution laches, it was reasonable for iPIX to conclude that this defense did not previously exist, and iPIX acted promptly to assert the defense upon learning of its availability of the defense. iPIX has, therefore, demonstrated good cause to seek leave to amend its answer after the deadline previously established for doing so has passed.

The question then becomes whether iPIX has satisfied the requirements of Rule 15(a). That rule requires that leave to amend a pleading be "freely given when justice so requires." This "facilitate[s] a proper decision on the merits" and identifies the material issues of the case. Foman v. Davis, 371 U.S. 178, 182 (1962). Oxaal offers no substantive reason why leave to file and serve the proposed amended answer should be denied and none appears from the face of the proposed amended answer and

counterclaim. Accordingly, iPIX's motion will be granted.¹

III. Conclusion

For the reasons stated above, it is hereby

ORDERED that iPIX's motion for leave to file and serve an amended answer and counterclaim (Docket No. 13) is **GRANTED**, and iPIX shall file and serve the amended answer and counterclaim on or before **April 5, 2002**; and

IT IS FURTHER ORDERED that a status conference will be held with counsel for both parties on **April 10, 2002 at 10:00 a.m.** in the chambers of the undersigned.

IT IS SO ORDERED.

DATED: March 27, 2002
Albany, New York

UNITED STATES MAGISTRATE JUDGE

¹Oxaal contends that if iPIX's motion is granted, it will require an extension of the present discovery deadline to allow discovery on the newly asserted defense. Pl. Mem. of Law (Docket No. 15) at 6-7. A status conference will be held to consider any extensions necessitated by this amendment.